Appl. No.: 10/651,499
Reply dated 02/07/2006
Reply to Office action of 12/07/2006

REMARKS/ARGUMENTS

Claims 1-4, 8, 12, 18 to 23, 28, 34-36, 39-41, and 50-55 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Ng et al., *Protein Crystallization by Capillary Counterdiffusion for Applied Crystallographic Structure Determination*, 142 J. of Structural Biology 218-231 (2003) ("Ng et al."). Claims 5-7, 9-11, 13-17, 24-27, 29-33, 37, 38, 42-49, and 56-62 have been rejected under 35 U.S.C. § 103(a) as being unpatenable over Ng et al.

In response to the above rejections, Applicants have previously submitted the Declaration of Dr. Ng in which Dr. Ng stated that Ng et al. was authored by himself and coinventors Jose A. Gavira-Gallardo and Juan M. Garcia-Ruiz. The declaration also stated that Ng et al. is the subject matter described and claimed in the present application. The Examiner has indicated that he found the declaration unpersuasive.

The Examiner asserts that Ng et al. is prior art under 35 U.S.C. § 102(a), which is reproduced as follows:

"A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," 35 U.S.C. § 102(a) (emphasis added).

According to the statute, a person is not entitled to a patent if it was described in a printed publication before the invention thereof by the applicant. In the present case, the cited reference describes Applicants' own work. Since the cited reference describes the work of the Applicants, it is physically and logically impossible for the Applicants to have described the invention in a printed publication before they invented the invention. Additionally, MPEP 2132.01 states that a rejection under 102(a) can be "overcome by submission of a specific declaration by the applicant that the article is describing applicants' own work." In the present case, Applicants' have submitted a declaration that establishes that cited reference describes Applicants' own work. Thus, it is respectfully submitted that Ng et al. cannot be considered prior art under 35 U.S.C. § 102(a), and therefore the rejections under 35 U.S.C. 102(a) and 103(a) have been overcome.

The Examiner has also raised issues as to the inventorship of the claimed invention. It seems that the Examiner believes that the Declaration has raised questions as to inventorship

because the Declaration of Dr. Ng did not specifically mention that Ng et al. also described the work of Greg Jenkins, and Mark Wells. In response to the Examiners questions, we offer the following remarks.

First, it should be fully understood that Greg Jenkins and Mark Wells are coinventors of the present application. Proof of their inventive contribution is provided by the signed declaration submitted on April 1, 2004 in which each inventor declared that they were a joint inventor along with the other named inventors. Moreover, Applicants' response dated September 28, 2005, specifically stated that "Dr. Ng is a co-inventor in the present application along with Jose A. Gavira-Gallardo, Juan M. Garcia-Ruiz, Greg Jenkins, and Mark Wells."

Second, Greg Jenkins and Mark Wells were not discussed in Dr. Ng's declaration because they were not coauthors of Ng et al., and therefore their contribution with respect to Ng et al. was immaterial. The Declaration only addressed the contribution of Dr, Ng, Jose A. Gavira-Gallardo, and Juan M. Garcia-Ruiz because they are all coauthors of the cited reference. The Declaration of Dr. Ng did not exclude Greg Jenkins or Mark Wells as coinventors or lessen their inventive contribution. Moreover, the definition of a coauthor is completely different of a coinventor and therefore the identification of authors is in no way indicative of inventorship in the subject matter of the work of authorship. For example, an article describing the invention of A, B and C may be authored by D and E without any reflection upon the inventive contributors of A, B and C. We hope that the above comments have cleared up any questions that may exist with respect to the inventorship of the claimed invention.

In view of the remarks made above, Applicant submits that the pending Claims are in condition for allowance. Applicant respectfully requests that the claims be allowed to issue. If the Examiner wishes to discuss the application or the comments herein, the Examiner is urged to contact the undersigned by telephone.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

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therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the U. S. Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.

Grace R. Rippy

February 7, 2006
Date